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Paper No. 13
DEB
Mailed:
February 21, 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Holmes Mirror Company
v.
Timothy's Fine Art d.b.a. Timothy's Hardware Company

Cancellation No. 31,610
to Registration No. 2,321,538
registered on February 22, 2000

Cleveland R. Williams of the Law Offices of Cleveland R.
Williams for Holmes Mirror Company

S. Daniel Harbottle of Rutan & Tucker for Timothy's Fine
Art d.b.a. Timothy's Hardware Company

Before Cissel, Bucher and Drost, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

On February 1, 2001, Holmes Mirror Company
(Petitioner) filed a petition to cancel Registration No.
2,321,538, owned by Timothy's Fine Art d.b.a. Timothy's
Hardware Company (Respondent). The registration, for the
mark Z-BAR, issued on February 2, 2000, as a result of an
application filed on March 1, 1999. The goods in the
registration are identified as "channel-locking metal bars
for hanging picture frames," in International Class 6. The

registration alleges a date of first use and a date of first use in commerce of November 1, 1995.

Petitioner claims that it used and promoted its Z-BAR mark in connection with closely related, if not identical, products, namely hanging devices, including channel-locking metal bars for hanging mirrors and picture frames, at least as early as 1987, and that there is a likelihood of confusion when the identical mark is used on these goods, and therefore, it seeks the cancellation of respondent's registration. In its answer, respondent denied the salient allegations of the petition to cancel, and set out numerous affirmative defenses. Both parties have filed briefs in the case. No oral hearing was requested.

The record consists of the file of the involved registration; respondent's notice of reliance on portions of the discovery deposition, with accompanying exhibits, of Frederick Holmes, co-owner of petitioner, Holmes Mirror Company; and respondent's notice of reliance on the trial testimony deposition, with accompanying exhibits, of Scott Bozanic, a general partner of respondent, Timothy's Fine Art d.b.a. Timothy's Hardware Company, a partnership organized under the laws of the state of California.¹

¹ The abbreviated trial testimony of Mr. Bozanic merely provides a foundation for the affected registration.

Petitioner attached exhibits to the petition to cancel and to petitioner's trial brief, but placed no evidence in the record during its testimony period.

Petitioner, as plaintiff, bears the burden of proving its case. Respondent is correct in pointing out that allegations made in the pleading, and exhibits attached thereto, are not evidence in plaintiff's behalf. See Perfect Film & Chemical Corp. v. Society Ordinastral, 172 USPQ 696 (TTAB 1972). Moreover, petitioner has taken no testimony nor introduced any evidence of any kind into the record herein during its testimony period.² Accordingly, petitioner cannot use its trial brief as a vehicle for the introduction of evidence. See Hard Rock Cafe International (USA) Inc. v. Elsea, 56 USPQ2d 1504 (TTAB 2000); TBMP §705.02 and cases cited therein.³

On the other hand, as noted earlier, respondent has properly placed into the record limited testimony as part of its testimony-in-chief. For example, those portions of Frederick Holmes' discovery deposition made of record by

Accordingly, in the context of this decision, it offered nothing relevant to the elements of petitioner's burden of proof.

² Additionally, as noted earlier, in its answer to the petition to cancel, respondent has not admitted any salient allegation of the complaint.

³ In light of this determination, we do not find it necessary to respond to respondent's other objections to these exhibits grounded in the Federal Rules of Evidence and/or the Trademark Rules of Practice.

respondent in accordance with 37 CFR §2.120(j) may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. See 37 CFR §2.120(j)(7); TBMP § 709 on Discovery Depositions; Chesebrough-Pond's Inc. v. Soulful Days, Inc., 228 USPQ 954 (TTAB 1985); Andersen Corp. v. Therm-O-Shield Int'l, Inc., 226 USPQ 431 (TTAB 1985); Anheuser-Busch, Inc. v. Major Mud & Chemical Co., 221 USPQ 1191 (TTAB 1984); and Miles Laboratories, Inc. v. SmithKline Corp., 189 USPQ 290 (TTAB 1975). However, only those limited portions of Mr. Holmes' discovery deposition that respondent has properly made of record may be referred to by any party, including petitioner, for any purpose permitted by the Federal Rules of Evidence.

Accordingly, we turn to relevant portions of Mr. Holmes' discovery testimony to determine whether there is any evidence in support of petitioner's claim of likelihood of confusion. The record establishes the following:

- In the summer of 1987, Mr. Holmes designed a product to hang heavy mirrors on the wall more securely than with previous systems petitioner had used; he also adopted and began using the term Z-BAR as his trademark for this product (Holmes 14:24 to 18:14).
- Petitioner began nationwide distribution of this hanging product sold under the Z-BAR trademark; the Z-BAR hanging product was sold in conjunction with

ninety percent of the mirrors petitioner sold; the mark was used, for example, on hanging instructions, but was never physically stamped or otherwise affixed directly onto the metal product (Holmes 23:15 to 24:23).

- Mr. Holmes is uncertain as to what percentage of petitioner's undisclosed gross revenues in any given year were derived from the sale of the involved goods herein (Holmes 33:11 to 39:14).
- Petitioner has no evidence of any misdirected communications intended for respondent (47:15 to 48-12).
- Petitioner has no explanation for the delay of one year from the time of learning of respondent's federal registration until the filing of the instant petition to cancel (50:13 to 54:12).
- On behalf of petitioner, Mr. Holmes knew of respondent's use of the mark Z-BAR in connection with the resale of petitioner's items within the picture frame industry. When respondent discontinued its purchase of petitioner's goods, petitioner was upset that respondent continued to use petitioner's trademark on similar goods; but prior to filing the instant petition to cancel, there is no evidence in the record that petitioner had ever objected to any type of use of Z-BAR by respondent (54:25 to 58:18).
- Mr. Holmes characterized petitioner's sales of this product to the picture framing industry as being "pretty insignificant," although he speculated that the percentage share of petitioner's business

devoted to the picture frame industry was ten percent (71:7 to 72:4).

- Petitioner erroneously used the designation "patent pending" on the involved product prior to actually filing a patent application with the United States Patent and Trademark Office (83:10 to 85:23).
- Abbey Schaefer Associates, a picture framing sales representative in Southern California, was for a period a sales rep for petitioner's Z-BAR hangers in the picture framing industry.

It is undisputed that petitioner has established its standing to bring this action and has a priority of use as to the term Z-BAR for channel-locking metal bars. However, in determining whether this record shows a likelihood of confusion, we must rely solely on those portions of Mr. Holmes' discovery testimony relied upon by respondent.

In the course of rendering this decision, we have followed the guidance of In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973). The du Pont case sets forth the factors that should be considered, if relevant, in determining likelihood of confusion.

It is clear that the marks herein are virtually identical -- a factor clearly favoring petitioner.

We turn next to the du Pont factors dealing with the similarity or dissimilarity and nature of the parties' respective goods and the similarity or dissimilarity of established, likely-to-continue trade channels.

Mr. Holmes testified that petitioner sells its Z-BAR hangers to the picture framing industry. That would support a conclusion that channel-locking metal bars used for hanging mirrors can be used interchangeably with channel-locking metal bars used for hanging picture frames [Holmes deposition, 71:7 to 72:4]. Moreover, the history of petitioner's and respondent's respective dealings with Abbey Schaefer Associates [Holmes deposition, p. 87] supports a conclusion that the goods of both parties move in the same channels of trade to the same ultimate customers.

As to the du Pont factor dealing with the nature and extent of any actual confusion, Mr. Holmes confirmed that petitioner has no evidence of instances of actual confusion. [Holmes deposition, 47:15 to 48-12]. Of course, evidence of actual confusion is notoriously difficult to obtain, so we cannot conclude from the lack of such evidence that confusion is not likely to occur. This is a neutral factor in this case.

We turn to a brief comment on another potentially relevant du Pont factor. The previous market interface between petitioner and respondent is not detailed in the evidence of record. Nonetheless, respondent argues in its brief that petitioner had consented to respondent's proprietary use of petitioner's mark. However, we note that one can read the portions of Mr. Holmes' testimony that respondent has placed into the record as establishing that respondent bought a large volume of petitioner's products bearing the mark over a period of years, and resold them, through its picture framing business, to respondent's retail customers. We find that respondent's distributor relationship with petitioner prior to 1999 cannot be accurately described as a transfer of petitioner's common law intellectual property rights based solely upon Mr. Holmes' ambiguous testimony on this subject, or by conclusions drawn therefrom by respondent's counsel.

Finally, we turn to another relevant du Pont factor herein, namely, the strength of petitioner's claimed mark. Although respondent has raised as an "affirmative defense" that this term is "in the public domain" (perhaps suggesting genericness), this issues has not been tried by the parties to this action. On the other hand, there is

certainly no evidence as to the strength of this mark that would favor petitioner. Hence, this too is a neutral du Pont factor in this case.

Accordingly, in evaluating the evidence of record herein in light of the relevant du Pont factors, we find that the marks are identical, the goods are closely related, if not overlapping, and we find that both parties have marketed their respective goods through identical channels of trade.

Decision: The petition to cancel is granted, and the above-identified registration will be cancelled in due course.